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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,777	03/22/2004	Lee H. Angros	233.032	9934

30589 7590 04/21/2006

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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/805,777	Applicant(s) ANGROS, LEE H.	
	Examiner Lyle A. Alexander	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-86,88,95-98,101,104,107-115,117,120-125 and 127-183 is/are pending in the application.
- 4a) Of the above claim(s) 136-183 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-86,88,95-98,101,104,107-115,117,120-125 and 127-135 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 83-86, 88, 95-98, 101, 104, 107-115, 117, 120-125 and 127-135, drawn to an applicator containing a transparent composition, classified in class 422, subclass 101.
- II. Claims 136-144, 154-161 and 169-183 are, drawn to an applicator device containing a composition, classified in class 435, subclass 288.3
- III. Claims 145-153 and 162-168 are, drawn to an applicator device containing a non-pigmented composition, classified in class 359, subclass 398.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II, III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as an applicator using a transparent composition. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as using a pigmented composition. See MPEP § 806.05(d).

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Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

that "dry" chemistry is advantageous over "wet" chemistry. Specifically, the wet chemistry usually require cumbersome equipment that usually lacks portability and intricate solution manipulation requiring a degree of skill. In contrast, the dry chemistry offers substantial advantages in storage, handling, does not require sophisticated equipment and can be performed by the layman.

Newly submitted claims 136-183 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: See the above restriction requirement.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 136-183 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 83-86, 88, 95-98, 101, 104, 107-115, 117, 120-125 and 127-135 rejected under 35 U.S.C. 103(a) as being unpatentable over Yanus et al. (USP 4,521,621).

Yanus et al. teach in column 12 lines 17+ polysiloxanes are transparent materials and are employed in 10-75% solutions, where the balance of the solution has been read on the claimed "solvent". Examples IV, VI, VII etc. the formation of a 200 Angstrom siloxane layers which have been read on the claimed layer of "... less than 0.0001 inch". Column 6 lines 24+ teaches the use of strong mineral acids. The claimed language "... applicator device is a pen or is pen-like" is sufficiently broad that it has been read on the means by which the 200 Angstrom layer was formed.

Yanus et al. are silent to the claimed "constructed of a material which is different from a material used to construct the body".

The court decided In re Larson (144 USPQ 347) the use of a one piece construction instead of a device made from different components would have been a matter of obvious engineering choice. It would have been desirable to make the elements of the Bird application that are not contacting the surface out of less expensive, light weight materials, such as a plastic. It would have been within the skill of the art to modify Yanus et al. and make the non-surface contacting portion of the Bird applicator out of a less expensive and light weight materials, such as plastic, as a matter of obvious engineering design choice.

Claims 83-84, 88, 95-96, 101,104, 107-112,115,117,120-122,125 and 127-135 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Badesha et al. (USP 4,855,201).

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Badesha et al. teach in examples I and IV a Bird Applicator applying a silicon layer having a thicknesses of 0.4 and 2 microns respectively in the presence of other solvating materials. This has been read on the claimed solvent and silicon layer of less than 0.0001 inch. The claimed language "... applicator device is a pen or is pen-like" is sufficiently broad that it has been read on the Bird Applicator.

Yanus et al. are silent to the claimed "constructed of a material which is different from a material used to construct the body".

The court decided In re Larson (144 USPQ 347) the use of a one piece construction instead of a device made from different components would have been a matter of obvious engineering choice. It would have been desirable to make the elements of the Bird application that are not contacting the surface out of less expensive, light weight materials, such as a plastic. It would have been within the skill of the art to modify Badesha et al. and make the non-surface contacting portion of the Bird applicator out of a less expensive and light weight materials, such as plastic, as a matter of obvious engineering design choice.

Response to Arguments

Applicant's arguments filed 2/7/06 have been fully considered but they are not persuasive.

Applicants' state the cited prior art fails to teach the new limitations "constructed of a material which is different from a material used to construct the body". The Office has cited Larson above to show the art recognizes that a single piece construction, such as the Bird applicator taught by the cited prior art, is interchangeable with multiple piece

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construction. Motivation for making the reservoir out of a different less expensive material was also provided and meets the instant claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander
Primary Examiner
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